

REMARKS

Please amend the attorney docket number to 19133.0132U1.

Claims 1-28 are pending and have been objected to and/or rejected under various bases. Claims 10-15, 21-22, and 25-27 have been amended herein.

Claim Amendments

While Applicants do not agree that the claims as originally filed are indefinite, in order to expedite prosecution, claims 10-15, 21-22, and 25-27 have been amended to more clearly indicate antecedent basis within each claim. Support for each amendment can be found within each claim, as originally filed. No new matter has been added.

Claim Rejections

Applicants note that none of claims 1-28 has been rejected under 35 U.S.C. § 102, thereby indicating that the pending claims are novel.

Rejections under 35 U.S.C. § 112, second paragraph

The office action has rejected claims 10-15, 21-22, and 25-26 as allegedly indefinite. Applicants respectfully disagree. Nonetheless, at the request of the Examiner, Applicants have amended the purportedly offensive claims to more clearly indicate antecedent basis within each claim. Claim 27 has been amended along similar lines. Applicants, therefore, respectfully assert that these rejections have been overcome and that the claims are in condition for allowance.

Rejections under 35 U.S.C. § 103(a)

The Office Action has rejected claims 1-28 as allegedly unpatentable over Bette K. Fishbein, "Carpet Take-Back: ERP American Style," *Environmental Quality Management*, Autumn 2000, pp.25-36 (hereinafter "Fishbein"). Without conceding that Fishbein is prior art to the present application, Applicants respectfully disagree with these rejections. More specifically, in order to establish a *prima facie* case of obviousness, the art of record must teach, or at least

suggest, the claimed invention as a whole. Moreover, there must be adequate motivation and a reasonable expectation of success to undertake the modifications proposed in the rejection. For at least the reasons discussed in detail below, these rejections are in error and should be withdrawn.

Undisclosed claim limitations cannot support a rejection

An asserted combination or modification must teach or suggest all claim limitations. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1970) (stating that all claim limitations must be taught or suggested by the prior art). Here, Fishbein fails to disclose several features recited in the pending claims, and, consequently, the Office Action mistakenly characterizes the disclosure of Fishbein in several instances.

First, the Office Action contends that Fishbein discloses sorting the collected carpet according to polymeric fiber on Page 27, Column 2, lines 1-17 and Page 28, Column 1, lines 27-39 (Office Action mailed March 15, 2006, page 3, lines 20-21 and page 9, lines 3-4). A careful reading of the cited Fishbein passages, however, reveals that Fishbein discloses that face fiber consists of a variety of polymers, including nylon, and that Honeywell will use “new technology to sort face fiber.” These passages arguably disclose that face fiber can be sorted, but nowhere in the cited passages is it disclosed to sort collected carpet according to polymeric fiber. Accordingly, to assert that Fishbein discloses sorting the collected carpet according to polymeric fiber is a mischaracterization of the cited passages, and, therefore, Fishbein does not disclose the pertinent recited feature.

Second, the Office Action contends that it would have been obvious “that the carpet would have to be installed in order to perform the step of maintaining the carpet,” as allegedly disclosed in Fishbein at Page 28, Column 2, lines 13-27 (Office Action mailed March 15, 2006, page 7, lines 9-12 and page 8, lines 2-7), and that “one would have been motivated to perform the installation step in order to entice customers to participate in the leasing arrangement” (Office Action mailed March 15, 2006, page 7, lines 12-13 and page 8, lines 7-9). A careful reading of the cited Fishbein passage and the following paragraph, however, reveals that the six-

Again Recycling Program applied to carpet made from BASF's nylon 6 fiber, but not necessarily installed by BASF. Further, Fishbein discloses that the replacement carpet need not be a BASF product, but could be made by any manufacturer; this does not, in fact, disclose that one maintaining the carpet had necessarily installed the carpet. Moreover, the cited Fishbein passages do not relate to any leasing arrangement, which is only disclosed later (*see, e.g.*, Fishbein at page 30, lines 34+). Accordingly, to assert that Fishbein discloses and motivates installation is a mischaracterization of the cited passage, and, therefore, Fishbein does not disclose the pertinent recited feature.

Third, the Office Action contends that Fishbein discloses an incentive to replace the carpet at Page 35, Column 1, Lines 33-46 (Office Action mailed March 15, 2006, page 7, lines 14-19 and page 9, lines 17-22) by suggesting that a free take-back program is an incentive. As disclosed in the present application, an incentive contemplates a non-zero benefit to the consumer:

The seller may then bid on the service to remove and recycle the used carpet and/or provide the consumer with a replacement carpet. In a most preferred embodiment, the seller provides the customer with an incentive to replace and recycle the carpet. Suitable incentives nonexclusively include cash, coupons, rebates, credits, and the like, and may optionally be applied towards future purchases or services from the seller. In a preferred embodiment, the consumer is required to apply such incentives to future purchases from the seller. In another embodiment, in order to receive an incentive a consumer must provide installed carpet information to the seller for the seller's database. In a most preferred embodiment of the invention, the consumer receives a credit towards a new carpet purchase from the seller. This practice serves to facilitate the recycling process while promoting business for the seller.

Specification at page 8, line 26 – page 9, line 7.

Nowhere in the cited passage does Fishbein disclose an incentive. The Office Action ignores the disclosure in the specification and mischaracterizes the disclosure of Fishbein by arguing that a take-back service that is free is an economic incentive to the customer. Such an argument is analogous to a lower-priced (as opposed to free) take-back service being an economic incentive to the customer. Accordingly, to assert that Fishbein discloses an incentive is a

mischaracterization of the cited passage, and, therefore, Fishbein does not disclose the pertinent recited feature.

Obviousness predicated on inherency cannot support a rejection

The office action contends, *inter alia*, that while

Fishbein does not explicitly disclose estimating the useful lifetime of the installed carpet, contacting the consumer, or collecting the carpet within a determined period of time from the end of the estimated useful lifetime of the carpet . . . this would have been inherently necessary in order to replace and recycle the carpet at the end of life when the carpet is provided on a leasing arrangement (Page 30, Column 2, lines 39-43).

Office Action mailed March 15, 2006, page 3, lines 14-19; page 8, line 19 – page 9, line 2; and page 10, lines 14-19 (emphasis added).

In other words, it is asserted that because certain steps (*i.e.*, estimating the useful lifetime of the installed carpet, contacting the consumer, and collecting the carpet within a determined period of time from the end of the estimated useful lifetime of the carpet) are inherent in replacing and recycling a carpet, it follows that one of ordinary skill in the art would find these steps obvious. This argument is both technically and legally flawed.

First, it is technically incorrect. Applicants respectfully point out that carpet can be replaced and/or recycled without performing any of the allegedly inherent steps (*i.e.*, estimating the useful lifetime of the installed carpet, contacting the consumer, and collecting the carpet within a determined period of time from the end of the estimated useful lifetime of the carpet). The carpet installation literature – including Fishbein itself – provides numerous examples of carpet being replaced and/or recycled without performing any of the allegedly inherent steps. More specifically, carpet can be replaced and/or recycled at a point in time unrelated to estimating the useful lifetime of the carpet; for example, carpet can be replaced and/or recycled at the end of an arbitrary time period or at the end of a leasehold period related to the consumer's personal or business needs. Similarly, carpet can be replaced and/or recycled without contacting

the consumer; for example, carpet can be replaced and/or recycled by using a predetermined carpet deposit station.

Second, it is legally incorrect. Applicants respectfully point out that obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. *See* MPEP 2141.02 V and *In re Rijckaert*, 9 F.2d 1531, 28 USPQd 1955 (Fed. Cir, 1993). Because the suggestion to combine or modify references must occur prior to an applicant's date of invention, an unknown inherency cannot supply this suggestion at the required time. Rather, to negate patentability, there must be something in the prior art to suggest the desirability of combining these individual elements as claimed by the applicant. *Fromson v. Advance Offset Plate, Inc.*, 755 F2d 1549, 1556, 225 U.S.P.Q.2d, 31-32 (Fed. Cir. 1985). Here, the office action merely concludes that the pertinent recited features (*i.e.*, estimating the useful lifetime of the installed carpet, contacting the consumer, and collecting the carpet within a determined period of time from the end of the estimated useful lifetime of the carpet) were both inherent and known at the time the invention was made. Obviousness cannot be established with unsupported conclusions.

Independent claims 1, 17, and 23 – as well the remaining pending claims, which depend therefrom – each recite the features of estimating the useful lifetime of the installed carpet, contacting the consumer, and collecting the carpet. As set forth above, these features are not inherent in replacing and/or recycling a carpet. Also, these features were not known at the time the invention is made, as evidenced by the failure of Fishbein to disclose them. Accordingly, this rejection is flawed and must be withdrawn.

Further, the office action contends that

While Fishbein does not explicitly disclose that a database is established and maintained that contains information regarding installed carpet and consumers it is obvious to one of skill in the art at the time the invention was made that a database containing the type of carpet, installation date, useful lifetime of the carpet, and consumer identification would have been necessary in order for Interface to purchase, maintain, replace the carpet over the period of the lease, and recycle it at the end of its useful life.

Office Action mailed March 15, 2006, page 3, lines 5-11 and page 10, lines 5-11
(emphasis added).

To establish that a feature is inherent in the disclosure of the cited reference, the Office Action must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Here, the Office Action has instead merely concluded that establishing and maintaining a database is necessary “in order to provide the leasing customer with the services that have been promised.” Such mere conclusion falls short of providing a basis in fact and/or technical reasoning.

Independent claims 1, 17, and 23 – as well the remaining pending claims, which depend therefrom – each recite the step of establishing and maintaining a database of installed carpet information comprising carpet type, installation date and consumer identification data. Because the Office Action has not provided a basis in fact and/or technical reasoning to reasonably support the determination that the step of establishing and maintaining a database necessarily flows from the disclosure of Fishbein, this rejection is flawed and must be withdrawn.

“Obvious to try” cannot support a rejection

The Office Action also contends, *inter alia*, that while Fishbein does not explicitly disclose certain recited features of the pending claims (*e.g.*, establishing and maintaining a database, estimating the useful lifetime of the installed carpet, and contacting the consumer within a determined period of time from the end of the estimated useful lifetime of the carpet), these features would have been obvious to one of skill in the art at the time of the invention. *See, e.g.*, Office Action mailed March 15, 2006 at page 3, lines 5-19; page 8, line 1 – page 9, line 2; and page 10, lines 5-19.

Applicants respectfully disagree that the pending claims are obvious. It is the burden of the Office to show that the prior art, when considered as a whole, teaches or suggests every element of Applicants’ claims. The suggestion or motivation asserted must also be supported by

objective evidence, not mere conclusory assertions. *See In re Dembiczak*, 175 F.3d 994, 999 (Fed Cir. 1999). The prior art must also provide a reasonable expectation of success for the proposed combination. *See In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed Cir. 1988). As noted above, the Office Action failed to carry its legal burden to establish and support with evidence from the prior art that Fishbein discloses each and every one of the recited features of the pending claims (*e.g.*, establishing and maintaining a database, estimating the useful lifetime of the installed carpet, and contacting the consumer within a determined period of time from the end of the estimated useful lifetime of the carpet).

At best, the unsupported conclusions of obviousness and assertions of self-evident motivation (*e.g.*, “in order to provide the leasing customer with the services that have been promised”), might suggest that it would be obvious to try the undisclosed recited features; however, neither Fishbein nor the Office Action provides any support for reasonable chance of success. And, as noted in MPEP § 2145, “obvious to try” is an improper standard under 35 USC § 103. This case is analogous to the situation described by the *In re O’Farrell* court. Specifically, the court stated that:

In some cases, what would have been “obvious to try” would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was “obvious to try” was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.

In re O’Farrell, 853 F.2d 894, 903 (Fed. Cir. 1988).

Here, the Office Action has completely failed to address whether Fishbein provides a reasonable chance of success of practicing the undisclosed recited features (*e.g.*, establishing and maintaining a database, estimating the useful lifetime of the installed carpet, and contacting the consumer within a determined period of time from the end of the estimated useful lifetime of the carpet) in connection with the methods disclosed in Fishbein. In the absence of addressing a reasonable expectation of success, the Office Action has instead clearly engaged in

impermissible hindsight reconstruction of the claimed invention. In this case, however, it is unlikely that the Office Action could have established a reasonable expectation of success of practicing the undisclosed recited features in connection with the methods disclosed in Fishbein. To the contrary, Fishbein teaches away from trying the allegedly obvious modifications alleged in the Office Action. Specifically, Fishbein discloses that “[t]he original Evergreen lease program did not succeed and very few leases were signed” when referring to a method wherein the carpet manufacturer retains responsibility for the carpet.

Accordingly, for at least these reasons, the Office Action has failed to sufficiently support a legally valid *prima facie* rejection for obviousness, and therefore failed to carry its burden of proof, and the rejections should be withdrawn.

CONCLUSION

In light of the foregoing Remarks, the claims are believed to be allowable, and Applicants respectfully request notification of same. The Examiner is invited and encouraged to directly contact the undersigned if such contact may enhance the efficient prosecution of the application to issuance.

Payment in the amount of \$120.00 for the One-Month Extension of Time is enclosed herewith. The payment is to be charged to a credit card and is authorized by the signed, enclosed document entitled: Credit Card Payment Form PTO-2038. No further fee is believed due. However, the Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,
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July 17, 2006
Date